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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,998	08/26/2003	John Pether	131279-1034	3085

60148 7590 04/17/2007
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EXAMINER

HYUN, PAUL SANG HWA

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/647,998

Applicant(s)

PETHER ET AL.

Examiner

Paul S. Hyun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/26/03, 11/24/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

REMARKS

Claims 1-21 are currently pending. In response to the written restriction dated 11/29/06, Applicants elected the prosecution of claims 1, 2 and 4-17 without traverse. Claims, 3 and 18-21 are hereby withdrawn from further consideration. However, claim 3 is subject to rejoinder upon the allowance of claim 2.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

It appears that the word "plan" was intended to be "plane" in [0012] of the Specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "window" recited in claims 7 and 8, the "access port" recited in claims 9 and 10, the "water introduction means" recited in claim 11, the "heating means" recited in claim 12, and the "cooling means" recited in claim 13 must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 2 is objected to because of the following informalities:

It appears that Applicants intended the limitation "plan" recited in line 2 of the claim to be "plane". Otherwise, the limitation does not make sense.

Claim 17 is objected to because of the following informalities:

The limitation "minimise" recited in line 2 of the claim should be changed to "minimize".

Claim 4 is objected to because of the following informalities:

The comma in line 2 of the claim should be deleted.

Claim 5 is objected to because of the following informalities:

The limitation "include" should be changed to "includes".

Claim 9 is objected to because of the following informalities:

The period in line 2 of the claim should be deleted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 2 and 4-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims recite a container with at least one wall that is configured to move against a biasing means in response to the increased pressure inside the container. The claim language suggests that the volume of the container increases as the at least one wall moves. If the volume of the container increases, then it is not clear how the load or the cover for the container can properly adjust for the increase in the dimensions of the container. It appears that the load or the top for the container must compliment the dimensions of the container during the intended use of the apparatus. Otherwise, the contents of the container (i.e. soil) would seep through the space between the cover/load and the increased dimensions of the container when the at least one wall moves.

2. Claims **1, 2 and 4-17** are rejected under 35 U.S.C. 112, first paragraph, because the Specification, while being enabling for an apparatus comprising walls that are configured to deform in response to increased pressure inside the apparatus, does not reasonably provide enablement for an apparatus comprising walls that are configured to move outwardly against a biasing means. The Specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite an embodiment of the apparatus that comprises at least one wall that is adapted to move against a biasing means. However, the Specification does not disclose how the movement is accomplished. The language of the claims suggests that the movement of the at least one wall is accompanied by an increase in the volume of the container. If the volume of the container increases, then the dimensions, such as

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length, of the walls that define the container must also increase. However, the Specification is silent with regards to the ability of the walls to change dimensions.

3. Claims **9 and 10** are rejected under 35 U.S.C. 112, first paragraph, because the Specification does not reasonably provide enablement for an apparatus comprising an access port for facilitating the access to the product disposed in the apparatus. The Specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 9 recites an access port located at one of the sides of the claimed apparatus. However, according to the Specification, the product is buried inside the soil. Therefore, it is not clear how the mere existence of a port can permit access to the product buried in the soil.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **4-6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is dependent on claim 2. Claim 2 recites that at least two walls are configured to move. Claim 4 recites that at least one wall is configured for movement. The limitation in claim 4 exceeds the narrower range of limitation recited in claim 2.

For examination purposes, the broader range (i.e. at least one wall) will be assumed.

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5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites that the wall that is configured to move is rigid, yet claim 5 recites that the wall that is configured to move is capable of resilient deformation. The scope of the limitation "rigid" as recited in the claims is unclear.

For examination purposes, the limitation "rigid" recited in the claims will be construed in the most broad manner possible within reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 5, 7, 8-12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kellner (US 4,483,197).

Kellner discloses an apparatus for testing products installed underground (see Fig. 1). The apparatus comprises a top opening/access port 30 for accommodating a pipe, a reservoir 32 for receiving soil, the reservoir defined by a base 24, a top/water introduction means 28, and substantially rigid sides 36 wherein the sides 36 are configured to move against biasing means in the form of pressure clamps 44 and 45 (see Fig. 1). Although the apparatus is cylindrical, it is rectangular in plane. The housing can be made from a transparent material (see line 65, col. 3). The apparatus can further

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comprise a heater for heating the soil sample (see lines 45-55, col. 5) and an anti-frictional coating 15 to minimize friction between the soil and the container. Although the reference does not explicitly disclose that sides are configured to move, the reference discloses that increasing pressure inside gas pressure reservoir 38 exerts pressure on the soil reservoir 32. Therefore, it is evident that sides 36 are configured to move in accordance to the increased pressure inside the gas pressure reservoir. Otherwise, the increase in pressure inside gas pressure reservoir 38 would not affect the soil reservoir.

7. Claims **1, 2, 4 and 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Deconinck (US 4,388,992).

Deconinck discloses a container comprising a base 36, sidewalls 23 and 25, and a top opening wherein base 36 is configured to move under application of weight to the base (see Fig. 1). The movement is biased by leaf springs 38-40 (see Fig. 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claim **13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner.

The apparatus disclosed by Kellner does not comprise a cooler. However, the apparatus does comprise a heater for simulating pipeline-operating temperatures (see lines 45-55, col. 5). In light of the disclosure, it would have been obvious to one of ordinary skill in the art to provide a cooler if the person conducting the test wanted to simulate the pipeline-operating conditions in a cold climate region.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
4/12/07


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